

### **REMARKS/ARGUMENTS**

The office action of May 11, 2005 has been carefully reviewed and these remarks are responsive thereto. Reconsideration and allowance of the instant application are respectfully requested. Claims 1, 2, 4-11 and 13-86 remain pending in this application. Claims 3, 12, 87 and 88 have been canceled without prejudice or disclaimer.

The following claims stand rejected under either 35 U.S.C. § 102(e) or 35 U.S.C. § 102(b):

- Claims 1-6 and 9-26 as being anticipated by U.S. patent no. 5,390,138 to Milne et al. ("Milne");
- Claims 27-29 and 31-32 as being anticipated by U.S. publication no. 2002/0194260 to Headley et al. ("Headley");
- Claims 33-36, 39-48, 50-56, 58, 60, 62-73, 75-76, 83-86 as being anticipated by U.S. patent no. 6,636,238 to Amir et al. ("Amir");
- Claims 77 and 81-82 as being anticipated by U.S. patent no. 6,529,920 to Arons et al. ("Arons"); and
- Claims 87-88 as being anticipated by U.S. patent no. 5,801,685 to Miller et al. ("Miller").

The following claims stand rejected under 35 U.S.C. § 103(a):

- Claim 7 as being unpatentable over Milne in view of U.S. patent no. 5,838,313 to Hou et al. ("Hou");
- Claim 8 as being unpatentable over Milne in view of U.S. patent no. 6,571,211 to Dwyer et al. ("Dwyer");
- Claim 30 as being unpatentable over Amir in view of U.S. patent no. 5,644,674 to Aihara et al. ("Aihara");
- Claim 37 as being unpatentable over Amir in view of Hou;
- Claim 38 as being unpatentable over Amir in view of Hou, as applied to claim 37, and further in view of Dwyer;
- Claim 49 as being unpatentable over Amir in view of U.S. patent no. 5,689,717 to Pritt;

- Claims 57 and 61 as being unpatentable over Amir in view of U.S. patent no. 6,144,375 to Jain et al. ("Jain");
- Claim 59 as being unpatentable over Amir in view of U.S. patent no. 6,418,421 to Hurtado et al. ("Hurtado");
- Claim 74 as being unpatentable over Amir in view of U.S. patent no. 6,055,538 to Kessenich et al. ("Kessenich"); and
- Claim 78-80 as being unpatentable over Amir in view of Miller.

Applicants respectfully traverse these rejections. Notwithstanding, Applicants are concurrently submitting a Second Declaration under 37 C.F.R. § 1.131 to antedate Amir and Arons. As evidenced by the declaration, applicants conceived and reduced to practice the invention of claims 33-86 prior to the earliest priority date of Amir and Arons, March 5, 1999. Accordingly, applicants submit that Amir and Arons do not qualify as prior art to the present invention. Since claims 33-76, 78-80 and 83-86 were rejected over Amir alone or in combination with another document, those rejections are submitted to be moot, and the claims allowable over the prior art of record. Also, since claims 77, 81 and 82 were rejected over Arons, that rejected is deemed moot and those claims are allowable over the prior art of record.

Also, applicants have canceled claims 87 and 88 without prejudice or disclaimer rendering their rejection moot.

#### **Rejections based on Milne**

The action alleges that Milne discloses all the elements of independent claims 1 and 10. Claim 1, as amended, calls for an audio input receiving audio annotations, and a processor for associating the received audio annotation with displayed electronic information, wherein the processor further associates an author with each of the audio annotations, each of the audio annotations being randomly accessible based on the author. Amended claim 10 calls for storage for storing audio annotations, each of the audio annotations including an author and being associated with the displayed electronic information, each of the audio annotations being randomly addressable based on the author. Milne neither teaches nor suggests a processor associating an author with each of the audio annotations, each of the audio annotations being randomly accessible based on the author. Nor does Milne provide a teaching of each of the audio

annotations including an author and being randomly addressable based on the author. For at least these reasons, claims 1 and 10 and their respective dependent claims 2, 4-9 and 11-26 are patentably distinct from Milne.

Neither Hou nor Dwyer, which are applied in the action in combination with Milne to reject claims 7 and 8, respectively, overcome the deficiencies of Milne.

**Rejections based on Headley**

The action contends that Headley discloses all the features of independent claim 27 and claims 28, 29, 31 and 32, which depend from claim 27. Applicants respectfully disagree.

Claim 27 calls for a user interface for displaying electronic information to a user including a first display portion for displaying a portion of a document, and a second display portion for displaying a graphical indication that the document includes an audio annotation associated with the displayed portion of the document. The action alleges that Figure 6 and paragraphs [0021], [0022] and [0047]-[0051] of Headley show the features of claim 27. Apparently, the action contends that static image 602 corresponds to a portion of a document and that video clip 604, which can be a music video clip, corresponds to an audio annotation associated with the static image 602. In any event, there is no teaching or suggestion of a graphical indication that the static image 602 or an element in the multimedia playlist 606 includes an audio annotation associated with the static image or an element in the multimedia playlist. Not only does Headley appear to provide no graphical indication of audio being associated with the static image or an element in the multimedia playlist, also, Headley is wholly devoid of an audio *annotation*. Music associated with a video in the form of a music video is certainly not an audio annotation and in no way suggests such to one of ordinary skill in the art. For at least these reasons, claim 27 is patentably distinct from Headley.

Claims 28, 29, 31 and 32 are patentably distinct from Headley for the same reasons as claim 27, and further in view of the advantageous features recited therein. For example, claim 31 calls for a third display portion for receiving a user input of a property or properties of the audio annotation. It is unclear to applicants how a multimedia playlist 606 as alleged in the action constitutes a property.

Claim 30 depends from claim 27 and was rejected according to the action over the combination of Amir and Aihara. Applicants believe that this may have been an error and the action may have intended to reject claim 30 over the combination of Headley and Aihara. In any event, Aihara does not remedy the defects noted with respect to Headley. Thus, the combination of Headley and Aihara, even if proper and intended, would not have resulted in the claim 30 invention.

### **CONCLUSION**

It is believed that no fee is required for this submission. If any fees are required or if an overpayment is made, the Commissioner is authorized to debit or credit our Deposit Account No. 19-0733, accordingly.


All rejections having been addressed, applicants respectfully submit that the instant application is in condition for allowance, and respectfully solicit prompt notification of the same.

Respectfully submitted,

BANNER & WITCOFF, LTD.

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By:

  
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